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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,718	03/08/2004	Patrice M. Fabre	027385-000200US	1798

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EXAMINER	
RECEK, JASON D	

ART UNIT	PAPER NUMBER
2442	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/796,718	FABRE ET AL.	
	Examiner	Art Unit	
	JASON RECEK	2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23,25 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23, 25 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is in response to the RCE filed on February 13th 2009.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/13/09 has been entered.

Status of Claims

Claims 1-23 and 25-26 are pending.

Claims 1-23 and 25-26 are currently rejected under 35 U.S.C 103(a).

Response to Arguments

2. Applicant's arguments, with respect to the rejection(s) of claim(s) 1, 15 and 20 under 103(a) have been fully considered and are persuasive. Specifically, the argument that the references relied upon do not disclose modifications of tracking strings (pg. 10) is persuasive. Therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Baus et al. US 2004/0172537 A1.

3. Applicant's arguments, pg. 9-10 have been fully considered but they are not persuasive. Applicant argues that the cited references do not disclose sending, receiving and forwarding being performed by the same device. This is not persuasive since the system disclosed by Knox includes a mail server that sends, receives and forwards email (paragraphs 15-17, Fig. 1).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knox et al. US2007/0005762 A1 in view of Weber et al. U.S. Pat. 5,878,230 and in view of Baus et al. US 2004/0172537 A1.

Regarding claim 1, Knox discloses “sending an initial e-mail message from said internal e-mail facility to the external contact” as sending an email message (paragraphs 15-16), and “e-mail message comprises a tracking string encoding tracking information

associated with said end user" as adding a tracking code to the email (paragraphs 6, 17).

Knox does not disclose "receiving … a first reply e-mail message from said external contact […] reply e-mail message having a TO field including said tracking string" however this is taught by Weber as replying to an email where the reply is automatically filled in with the address of the originator (col. 1 ln. 25-27, 60-64) since the tracking string was in the REPLY-TO field, it will also be in the TO field of the reply. Weber also discloses, "sending … a modified version of said first reply e-mail message to a native e-mail address of the end user" as sending the reply email to a different address from which the email was originally sent (col. 1 ln. 60-64, col. 3 ln. 20-30), "REPLY-TO field of said initial e-mail message corresponds to a domain of said internal e-mail facility" and "a REPLY-TO field of said modified version of said first reply e-mail message corresponds to said domain of said internal e-mail facility" as inserting the sender's address in the reply-to field (col. 1 ln. 25-27). This reply to field is present in all emails whether it is the first email or the sixth email in a chain of replies.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knox with the reply features taught by Weber for the purpose of tracking email because replying to email and reply-to addresses are well known in the art and yield predictable results.

Neither Knox nor Weber explicitly disclose "a first modified version of said tracking string" however this is taught by Baus as modifying tracking data (abstract, paragraph14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knox and Weber by using modifiable tracking codes as taught by Baus for the purpose of tracking emails. Knox teaches inserting the tracking string into a hyperlink (paragraph 18). Baus concerns tracking items over a web site. These are similar fields (i.e. a web site is accessed by hyperlinks) which may be combinable. Baus suggests that by allowing modification of tracking data, tracking may be improved (paragraphs 8-14). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to insert a modified tracking string into the REPLY-TO field for the purpose of tracking emails.

Regarding claim 2, Knox discloses "generating a first metadata object based on said tracking string" as generating a cookie based on tracking information (paragraph 20), and "metadata object associates […] said end user, said external contact, and at least one business functionality" as associating who sent the email, the recipient and the behavior (business information) of the recipient (paragraph 26), and "archiving" as storing email messages in a database (paragraph 28, Fig. 1).

Regarding claim 3, Knox discloses "generating a viewable communication log screen including information derived from said first metadata object" as displaying information from the metadata object to a user (paragraphs 40-41).

Regarding claim 4, Knox does not disclose "second reply e-mail message having a TO field including said first modified version of said tracking string" however this is taught by Weber as automatically filling in email fields with the address of the originator (col. 1 ln. 25-27) since the REPLY-TO field had the tracking string the TO field of the reply would also have the tracking string. Weber also discloses "sending a modified version of said second reply e-mail message to the external contact" as forwarding an email (col. 5 ln. 30-42), "a domain of a REPLY-TO field of said modified version of said second reply e-mail message corresponds to said domain of said internal e-mail facility" since the message is sent from the internal facility the reply-to field would necessarily contain the domain of the internal e-mail facility (col. 1 ln. 25-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knox with the reply features taught by Weber for the purpose of tracking email because replying to email and reply to addresses are well known in the art and yield predictable results.

Knox and Weber do not specifically disclose "receiving a second reply e-mail message from said end user" however replying to email is well known in the art and

yields predictable results, thus it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knox and Weber by having a user send a reply email. Also Know and Weber do not specifically disclose "a local part of said REPLY-TO field comprises a second modified version of said tracking string" however Knox discloses inserting tracking string into email (paragraph 25) and it would have been obvious to one of ordinary skill in the art at the time of the invention to put the tracking string in the reply-to field for the reasons given in the rejection of claim 1.

Regarding claim 5, Knox discloses "generating a second metadata object based on said second modified version of said tracking string" as generating a secondary cookie (paragraph 32) which performs the same functions as the first such as: "associates said second reply e-mail message with said end user, said external contact, and said at least one business functionality" (paragraph 26), and "archiving said second reply e-mail message" as storing the email message in a database (paragraph 28, Fig. 1).

Regarding claim 6, Knox discloses "generating a viewable communication log screen including information derived from said first metadata object and said second metadata object" as displaying information from the metadata objects to a user (paragraphs 40-41, 43).

Regarding claim 7, Knox discloses “native e-mail system of said end user is a web-hosted e-mail service” as a web-based email (paragraph 15).

Regarding claim 8, Knox discloses “native e-mail system of said end user is a dedicated desktop e-mail application” as a application email program (paragraph 15).

Regarding claim 9, Knox discloses “internal e-mail facility is operated out of a same Internet domain as said web-based business information system” as a user sending email from his business association which is associated with a single domain (paragraph 15).

Regarding claim 10, Knox discloses “initial e-mail message comprises a message body manually composed by the end user” as a user composing an email (paragraph 15).

Regarding claim 11, Knox discloses “initial e-mail message is automatically sent on behalf of the end user by said web-based business information system” as an email client sending email (paragraph 16).

Regarding claim 12, Knox discloses “REPLY-TO field of said initial e-mail message further comprises a display name for said end user that is substantially

identical to a display name associated with said end user in said native e-mail system" as an email address that consists of the user's initials (Fig. 2).

Regarding claim 13, Knox discloses "web-based business information system is provided by an application service provider and subscribed to by a business enterprise" as a business user whose email is provided by a service provider such as Yahoo (paragraph 15).

Regarding claim 14, Knox discloses "web-based business information system is self-hosted by a business enterprise" as a business which owns the domain and thus the email system is 'self-hosted' (paragraph 15).

Regarding claim 15, it is identical to claim 1 with the exception of "reply-to" replaced with "reply-designating header" in light of Applicant's specification (paragraph 76), Applicant's claim 18 and Applicant Admitted Prior Art RFC 2822 pg. 21 the term "reply-designating header" is broader than the term "reply-to" and thus claim 15 is rejected for the same reasons as claim 1.

Regarding claims 16-17, they correspond to claims 2 and 4 respectively and therefore are rejected for similar reasons.

Regarding claim 18, the limitation "reply designating header fields [...] are each REPLY-TO fields" makes claim 18 correspond in scope to claim 4, and is therefore rejected for similar reasons.

Regarding claim 19, neither Knox nor Weber specifically disclose "reply designating header fields [...] are each FROM fields" however it would have been obvious to one of ordinary skill in the art at the time to the invention to substitute reply-to fields with from fields. From fields are well known in the art as evidenced by Applicant Admitted Prior Art RFC 2822 pg. 21 and yield predictable results.

Regarding claim 20, it is similar to claims 1 and 15 and those similar parts are rejected for the same reasons given in the rejection of claims 1 and 15. Claim 20 adds the limitations "first thread-recurrent field of said initial e-mail message comprises a tracking string" and "a second thread-recurrent field" that comprises a "first modified version of said tracking string". Thread recurrent fields are disclosed by Knox as subject fields of an email (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knox and Weber by adding a tracking string to a subject field of an email. That technique is well known in the art and yields predictable results.

Regarding claim 21, it is identical to claim 2 and is therefore rejected for the same reasons.

Regarding claim 22, it is substantially similar to claim 4 and the similar parts are thus rejected for the same reasons. Claim 22 adds the limitation "thread-recurrent field". As discussed in the rejection of claim 20 Knox discloses thread recurrent fields (Fig. 2).

Regarding claim 23, it is identical to claim 18 and is therefore rejected for the same reasons.

Regarding claim 25, Knox discloses "said first, second, and third thread-recurrent fields are each SUBJECT fields" as subject fields in an email (Fig. 2). As discussed in claim 20, it is well known to place tracking information in a subject field of an email.

3. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knox and Weber and Baus in view of Bargagli Damm et al. US 2004/0006598 A1.

Regarding claim 26, Knox, Weber and Baus do not disclose "said first, second and third thread-recurrent fields are encrypted into body fields of said initial e-mail message" however encryption of email objects is taught by Bargagli Damm (paragraph 98) including encryption of an email header (paragraph 105).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knox, Weber and Bloomfield by adding encryption taught by Bargagli Damm for the purpose of security. Encryption is well known in the art and provides predictable results.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sampson US 2005/0050007 A1 discloses using tokens to track email.

Error et al. US 2004/0122943 A1 discloses modifying tracking codes for the purpose of event tracking.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Thurs 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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